

**REMARKS**

Favorable reconsideration of this application is respectfully requested in view of the following remarks.

Claims 1-6, 12-21, 23, 24, 27, 28, 30 and 32-35 are pending in this application. Claims 1, 24 and 28 are independent. Claims 4-6 are withdrawn as being drawn to the non-elected species. Claims 4-6 should be rejoined and allowed when independent Claim 1 is allowed.

The Official Action rejects independent Claims 1, 24 and 28 under 35 U.S.C. §103(a) over U.S. Patent No. 5,769,796 to Palermo et al. ("Palermo"), in view of U.S. Patent No. 7,074,197 to Reynolds' et al. ("Reynolds"). The rejection is respectfully traversed.

Independent Claim 1 recites a guide wire comprising, *inter alia*, a first wire disposed on a distal side of the guide wire, and a second wire disposed on a proximal side from the first wire. The proximal tip of the first wire and the distal tip of the second wire are coaxial. The first wire includes a proximal end face and the second wire includes a distal end face. The proximal end face of the first wire and the distal end face of the second wire abut one another and are welded to one another to form a welded portion. Independent Claims 24 and 28 recite similar features.

Palermo discloses a guidewire 140 including a distal section 146 having a tapered portion 122 and a spade 134 as shown in Figs. 1, 2 and 5A. As shown in Figs. 5A and 5B, the guidewire 140 includes a ribbon 126 which is said to correspond to the claimed first wire. The Official Action acknowledges that the proximal tip of the ribbon 126 ("first wire") and the distal tip of the distal section 146

(said to correspond to the claimed second wire) are not coaxial, and that the proximal end face of the ribbon 126 and the distal end face of the distal section 146 do not abut one another. To address these deficiencies, the Official Action refers to the guidewire disclosed in Reynolds, particularly the guidewire illustrated in Figs. 4 and 9.

The guidewire 10 illustrated in Fig. 4 of Reynolds has a proximal section 14 joined with a distal section 16 via a butt joint 13. Fig. 9 of Reynolds shows a guidewire 210 having a proximal section 214 joined with a distal section 216 by way of a tapered joint 212. The guidewire 210 also has a constant diameter portion 254, and a ribbon 258 as shown in Fig. 9. The ribbon 258 is disposed adjacent the distal end 260 of the constant diameter portion 254 at an attachment point 264. The Official Action takes the position that it would have been obvious to one of ordinary skill in the art to modify the configuration of Palermo's ribbon 126 ("first wire") and distal section 146 ("second wire"), based on Reynolds's configuration of the proximal sections 14/214 and the distal sections 16/216, to result in the claimed first and second wire. Applicants respectfully disagree.

To the extent an ordinarily skilled would view the Reynolds disclosure relevant to Palermo's guidewire, the disclosures in Palermo and Reynolds considered as a whole do not support the rejection. At best, one of ordinary skill in the art would equate the ribbon 258 of Reynolds' guidewire 210 with Palermo's ribbon 126, as both ribbons extend from an end cap (110 in Palermo and 269 in Reynolds) and are offset from the distal tip of the distal section (146 in Palermo and 216 in Reynolds). In the same respect, the ordinarily skilled artisan, considering the disclosures in Palermo and Reynolds as a whole, would equate Reynolds's proximal section 14 and distal

section 16 with Palermo's proximal section 142 and distal section 146, respectively. Thus, assuming the skilled artisan would have sought to modify aspects of Palermo's *ribbon* 126 based on the Reynolds disclosure, the artisan would have looked to aspects of Reynolds's ribbon 258, not Reynolds's proximal section 14/214 and distal section 16/216. To the extent it is said one skilled in the art would have modified aspects of Palermo's guidewire based on the configuration of Reynolds's proximal section 14/214 and distal section 16/216, such a modification would have been applied to Palermo's proximal section 142 and distal section 146, not Palermo's ribbon 126.

In addition, Palermo discloses that the inner helical coil 132 shown in Figs. 5A and 5B secures the end cap 110 via the ribbon 126 (see col. 7, lines 4-7 of Palermo). Accordingly, modifying Palermo's ribbon 126 ("first wire") so it is coaxial with the distal section 146 ("second wire") and so that the proximal end face of the ribbon 136 abuts the distal end face of the distal section 146 would weaken the connection of the end cap 110 to the guidewire. For example, the surface area of the proximal end face of the ribbon 126 available for the connection is much smaller than the surface area of the portion of the ribbon 126 connected to the inner helical coil 132 as shown in Fig. 5B. There exists no apparent reason why an ordinarily skilled artisan would deem it desirable to weaken this connection. And the Official Action does not address this point. One of ordinary skill in the art would not have modified Palermo's ribbon 126 to join the ribbon 126 with the distal section 146 in the same manner that Reynolds' proximal section 14/214 and distal section 16/216 are joined. The Office Action fails to consider the references and claims as a whole, and relies on

impermissible hindsight using knowledge gleaned only from Applicants' disclosure (see MPEP §2145(X)(A)).

Further, as clearly shown in Fig. 9 of Reynolds, the proximal tip of the ribbon 258 is offset from the distal tip of the distal section 216. The ribbon 258 is not coaxial with the distal tip of the constant diameter portion 254. Further, the proximal end face of the ribbon 258 in Reynolds and the distal end face of the constant diameter portion 254 do not abut one another to form a welded portion. Thus, the configuration of Reynolds's ribbon 258 fails to overcome the deficiencies of Palermo's ribbon 126 with respect to the independent claims at issue here.

In view of the above, the combination of Palermo and Reynolds fails to disclose, and would not have rendered obvious, a guide wire having the combination of features recited in the independent claims, including the proximal tip of the first wire and the distal tip of the second wire being coaxial, and the proximal end face of the first wire and the distal end face of the second wire abutting one another and being welded to one another to form a welded portion as recited in independent Claims 1, 24 and 28. More specifically, the Official Action does not provide adequate findings of fact supporting the conclusion of obviousness. Therefore, independent Claims 1, 24 and 28 are patentable over Palermo and Reynolds for at least these reasons.

The dependent claims are patentable over Palermo and Reynolds at least by virtue of their respective dependence from patentable independent Claims 1 and 24. Thus, a detailed discussion of the additional distinguishing features recited in these dependent claims is not set forth at this time. Withdrawal of the rejection is respectfully requested.

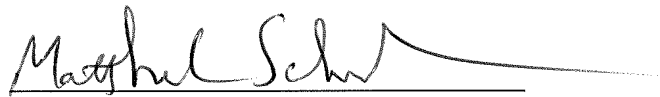
Should any questions arise in connection with this application, or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: August 18, 2009

By:

A handwritten signature in black ink, appearing to read "Matthew L. Schneider", written over a horizontal line.

Matthew L. Schneider  
Registration No. 32814

David R. Kemeny  
Registration No. 57241

P.O. Box 1404  
Alexandria, VA 22313-1404  
703 836 6620